

REMARKS/ARGUMENT

Claims 1-10, 24-29, 31, 32, and 34-43 are pending in the present application. Claims 11-23, 30, and 33 were previously cancelled, without prejudice or disclaimer. Claims 2-4, 24, 25, 27, 29, 31, 32, 3, 29, 31, 34, 39, 40, 42, and 43 have been amended. The amendments to the claims generally correct certain inadvertent clerical errors and inaccuracies. No new matter has been introduced into the present application.

Reconsideration and allowance in view of the above amendments and the below comments is respectfully requested.

Objections to the Specification

The specification was objected to on allegations of failing to provide proper antecedent basis for the subject matter within claims 1, 25 and 34-36. In particular, the Office action alleges that the specification lacks antecedent basis for the recitation of the claimed illumination light guide having: (1) an outside perimeter; (2) a first illumination end and a second illumination end; (3) a polygonal cross-section comprising a plurality of sides that define the outside perimeter; and (4) each side of the illumination light guide bordering a corresponding overillumination redirection facet. *See Non-Final Office Action*, mailed Aug. 18, 2009 (hereinafter “Non-Final Office Action”), at 2, ¶¶ 2 and 3. Applicants respectfully traverse these objections as erroneous.

35 U.S.C. § 112 and 37 C.F.R. § 1.71 require the specification be clear, concise, and exact so as to **enable** any person skilled in the art to which the invention pertains to **make and use the same**. *See infra*, at 8-11 (discussion of the enablement requirement); *see also* MPEP 608.01. Any structural detail that is essential for a proper understanding of the disclosed invention can be shown in the drawings. MPEP §§ 608.02(d), (e); *see, e.g.* MPEP 2163.02 (One complies with § 112, ¶1, “by such descriptive means as words, structures, **figures**, diagrams, formulas, etc., that fully set forth the claimed invention.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis added)). Only when the language of the claims departs from the nomenclature understood by those of ordinary skill in the art, in light of the specification as a whole, may an applicant be required to make amendment(s) to the specification so as to have the exact language in the specification for the terms appearing in the claims. *See,*

e.g., 37 C.F.R. § 1.75; MPEP §§ 608.01(i), 1302.01; *Ex parte Kotler*, 1901 C.D. 62 (Comm'r Pat. 1901).

Applicants' specification, as originally filed, provides full support for the claim limitations identified above. A person of ordinary skill in the art to which the present disclosure pertains would understand what constitutes "an outside perimeter" of the claimed illumination light guide, what "a first" and "a second ... end" of the claimed illumination light guide consists of, what a "polygon" is, etc., without needing a lexicographic definition or having the exact terms in the written description portion of the specification. Moreover, as acknowledged in the Office Action, support for these limitations may be found in the Applicants' drawings, as originally presented.

For at least the foregoing reasons, Applicants request that the objections to the specification be withdrawn.

Rejection of Claim 31 Based on 35 U.S.C. § 112, First Paragraph

Claim 31 was rejected by under 35 U.S.C. § 112, first paragraph, for failing to enable a person of ordinary skill in the art to which it pertains to make and use the invention. In particular, the Office Action alleges that the recitation of the read window being disposed perpendicular to the light pathway is inaccurate. *See* Non-Final Office Action, at 4. The Office Action then notes that "the read window is disposed perpendicular to the illumination light guide." *Id.*

In order to expedite prosecution of the subject application, Applicants have amended claim 31 to clarify that "[the] read window is disposed approximately perpendicular to a longitudinal axis of said illumination light guide." The read window being disposed approximately perpendicular to the light pathway or the illumination light guide is disclosed, for example, in FIG. 1 pre-grant publication number 2004/0142370. Accordingly, Applicants' request reconsideration and withdrawal of the 112, ¶1, rejection to claim 31.

Rejection of Claims 1-10, 24-29, 31, 32, 34-43 Based on 35 U.S.C. § 112, First Paragraph

Claims 1-10, 24-29, 31, 32 and 34-43 were rejected under 35 U.S.C. § 112, first paragraph, for failing to enable a person of ordinary skill in the art to which it pertains to make

and use the invention. In particular, with respect to independent claims 1, 25, and 29, the Office Action that the specification does not provide enablement for “any optical format in which the detection guide **is not** disposed approximately parallel to the illumination light guide,” or “any optical format in which the light may be guided around **without** the provision of facets 30 and 38”. Non-Final Office Action, at 3 (emphasis added). *See also, id.*, at 4. In addition to these purported omissions, the Office Action also alleges that claims 25-29, 31 and 32 **are not enabled for failing to recite** “the read window [being] positioned perpendicular to illumination light guide”. *Id.*, at 4. Similarly, for claims 34-41, the Office Action alleges that the specification does not provide enablement for an optical format **without the limitations enumerated above** with respect to independent claims 1, 25, and 29, and does not provide enablement for an optical format with “more or fewer [than four overillumination redirection] facets”. *Id.*, at 5. Finally, with regard to claims 35 and 36, the Office Action alleges that the specification “does not reasonably provide enablement for a polygonal cross-section comprising a plurality of sides that define an outside perimeter.” Applicants respectfully traverse these rejections as erroneous and contrary to MPEP directives and controlling Federal Circuit precedent.

The “enablement requirement” refers to the mandate of 35 U.S.C. § 112, first paragraph, that the specification describe how to make and how to use “the invention”. *See* MPEP 2614. The “invention” that must be enabled is that which is defined by the claims of the application. *See* MPEP 2164.08 (“All questions of enablement are evaluated against the claimed subject matter.”); *see, e.g.*, *CFMT, Inc. v. YieldUP Int'l Corp.*, 349 F.3d 1333, 1338 (Fed. Cir. 2003). The objective standard for determining compliance with the § 112, first paragraph, enablement requirement, as established by judicial precedent and codified by MPEP guidelines, is “whether that disclosure, when filed, contained **sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art** to make and use the claimed invention.” MPEP 2164.01 (emphasis added); *see In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). In particular, the fundamental test for enablement is whether one of ordinary skill in the art would need to engage in “undue experimentation” to practice the claimed invention. *See* MPEP 2164.01.

The focal point of any enablement analysis is whether the specification, as filed, supports that which is set forth in the claims, **not** whether the specification supports that which is **not** set forth in the claims. *See, e.g.*, MPEP 2164.08. The fact that “claims are interpreted in light of the

specification does not mean that everything in the specification must be read into the claims.” *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984). In fact, an applicant is not required to limit his claims solely to “what he has found will work or to materials which meet the guidelines specified for ‘preferred’ materials;” to demand otherwise “would not serve the constitutional purpose of promoting progress in the useful arts.” *Ex parte Shinozaki*, Appeal No. 1999-0465 (BPAI 2001), citing *In re Goffe*, 542 F.2d 564, 567 (CCPA 1976).

Not everything necessary to practice the invention need be disclosed to comply with 35 U.S.C. 112. See *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991). That is, the specification need not contain specific examples of every possible embodiment “if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. MPEP 2164.02, citing *In re Borkowski*, 422 F.2d 904, 908 (CCPA 1970). In fact, “[a]ll that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art.” See *id.*; see also, MPEP 2164.08.

Each claim need not encapsulate every conceivable permutation of the invention to meet 112 requirements. See M.P.E.P. §2111.01; *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004); see also, *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment). “As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.” *In re Fisher*, 427 F.2d 833, 839 (CCPA 1970) (emphasis added).

Failure to disclose every possible variation or alternative by which the claimed invention may encapsulate does not render a claim invalid under 35 U.S.C. 112. See, e.g., *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 (Fed. Cir. 2004). For example, in *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, the Federal Circuit found a patent specification fully enabling even though it listed elements that “could form thousands” of end products, some of which were

not expressly discussed in the specification and some of which may not have been operative. 750 F.2d 1569 (Fed. Cir. 1984); *see also, Utter v. Hiraga*, 845 F.2d 993 (Fed. Cir. 1988).

The pending 112, ¶1, rejection of claims 1-10, 24-29, 31, 32, and 34-43 fails to substantiate, under MPEP requirements and controlling Federal Circuit law, that Applicants' specification does not properly enable the pending claims. The various 112, ¶1, rejections are all premised on the assertion that the specification discloses certain characterizing limitations that are consistent throughout the different exemplary embodiments, yet not recited in the independent claims. For example, the rejection of claim 1 is based solely on the assertion that the specification does not discuss a format where (1) the detection guide is **not** disposed parallel to the illumination light guide, and (2) **without** the provision of facets 30 and 38. Furthermore, the assertions of the Non-Final Office Action are irrelevant. As noted above, enablement is determined based on the invention "as claimed," **not the invention as not claimed**. The Federal Circuit panel in *Raytheon Co.* made it abundantly clear that there is **no** necessity for the claims to imbibe everything from the specification to comply with 112, ¶1. For instance, the pending independent claims do not lack enablement for failing to require the format have defined edges and corners even though the illustrated exemplary embodiments are shown as having many defined edges and corners. Since Applicants are **not** required to limit their claims to a particular preferred embodiment, *see In re Goffe*, 542 F.2d at 567, the pending rejections of claims 1-10, 24-29, 31, 32, and 34-43 are erroneous, and should be withdrawn.

All questions of enablement are evaluated against the subject matter as claimed and are viewed from the perspective of those of ordinary skill in the art. *See, e.g.*, MPEP 2164.08. Applicants submit that the specification, as filed, depicts and/or discusses, with particularity, each and every element and limitation of base claims 1, 25, 29 and 34. The Office Action does not contest the fact that there is sufficiently enabling support for the limitations in the pending base claims. Rather, as noted above, the 112, ¶1, rejections are erroneously based on the contention that the specification does not enable a format **without** the limitations the Office Action alleges to be essential. However, because the Applicants' specification contains sufficient information to enable one skilled in the pertinent art to make and use **the claimed invention**, the 112, ¶1, enablement requirement is satisfied. The Office Action's improper allegation that Applicants' specification does not contain specific examples for every possible

permutation of the invention is immaterial. The claimed invention is properly disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *See MPEP 2164.02; In re Borkowski*, 422 F.2d at 908.

For at least these reasons, Applicants' request that the 35 U.S.C. § 112, first paragraph, rejections of claim 1-10, 24-29, 31, 32 and 34-43 be withdrawn and the claims allowed.

CONCLUSION

Applicants submit that claims 1-10, 24-29, 31, 32 and 34-43 are in condition for allowance and action toward that end is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the telephone numbers provided.

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It is believed that no fees are due; however, should any fees be required (except for payment of the issue fee), or credits be due, the Commissioner is authorized to deduct the fees from, or credit any overpayments to, Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247082-000274USPT.

Respectfully submitted,

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